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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,912	12/15/2000	Peter Michael Karas	10722-31459	2437

26702 7590 10/19/2004

MORRIS, MANNING & MARTIN LLP  
6000 FAIRVIEW ROAD  
SUITE 1125  
CHARLOTTE, NC 28210

EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3661

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/737,912

Applicant(s)

KARAS ET AL.

Examiner

CUONG H. NGUYEN

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action is the answer to the Appeal Brief submitted on 6/18/2004. This paper has been placed of record.

2. Claims 1-29 were pending in this application. Claims 9-10 are cancelled.

**Response to the Appeal Brief:**

3. Better grounds of rejection are advised in the Appeal Conf. 10/07/04 because the claimed subject matter does not overcome Small (US Pat. 5,513,117); therefore, the applicants' arguments are moot. The Appeal Conferees advise to reopen prosecution.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 17-28 are rejected under 35 U.S.C. § 102(b) as being anticipate by Small (US Pat. 5,513,117).

A. As to independent claim 17: Small teaches a computer network system for enabling a sender having access to a server of an online seller to order and have delivered

directly to a recipient a customised greeting message having a negotiable payment instrument included (see Small, Fig.4, and Fig.11 ref. 180);, comprising:

- (a) means for selecting a graphic image for inclusion in the message (see Small, Fig.7 ref. 106);
  - (b) means for specifying customised text for inclusion in the message (see Small, Fig.7 ref. 106);
  - (c) means for specifying a payee for the negotiable payment instrument (see Small, Fig.7 ref. 122);
  - (d) means for selecting the monetary value of the negotiable payment instrument (see Small, Fig.7 refs. 113-114);
  - (e) means for specifying billing information for the message and the negotiable instrument, wherein the billing information includes a financial institution of the sender (see Small, Fig.7 ref. 121, and Fig.4 ref. 66);
  - (f) means for requesting billing authorization from the financial institution of the sender (see Small, Fig.7 ref. 104, and Fig 11 ref. 181)
  - (g,) means for printing the message and negotiable payment instrument (see Small, Fig.4 ref. 54; and Fig.6 ref. 83);
- and
- (h) means for mailing the message and negotiable payment instrument to the recipient (see Small, Fig.6 ref. 83).

B. As to claim 18: Small teaches a system according to claim 17, further comprising means for displaying a data entry form to the sender over a computer network, the form having a plurality of data entry fields for displaying the graphic, the customized text, and the monetary value of the negotiable payment instrument (see Small, Fig.11 ref. 180, and Fig.13, ref.71).

E. As to claims 20-21: Small teaches a system according to claim 2Q, wherein the graphic image and customized text are pre-selected based on the occasion (see Small, Fig.12 ref. 71 wherein different occasions can be selected to send in advance).

F. As to dependent claims 19, 22: Small teaches a system according to claim 21, wherein the graphic image and customized text are modifiable by the sender (see Small, Fig.11 ref. 180).

G. As to dependent claim 23: Small teaches a system according to claim 17, further comprising means for displaying a preview of the printed message and the negotiable payment instrument to the sender (see Small, Figs. 1, 11, 13 - this is an inherent feature of Small's computer before pressing a button on a keyboard to execute/distribute a greeting message and a negotiable instrument).

H. As to dependent claim 24: Small teaches a system according to claim 17.

Small teaches a means for enabling the sender to specify a delivery date for the message and negotiable payment instrument - that means in a keyboard (see Small, Fig.2 ref. 11).

I. As to dependent claim 25: Small teaches a system according to claim 17, wherein the recipient and the payee are the same (see Small, Fig.11 ref. 180, and 181 wherein Connie's father is a recipient and a payee).

J. As to dependent claim 26: Small teaches a system according to claim 17, wherein the recipient and the payee are different; i.e., a baby as a recipient and a mother as a payee.

K. As to dependent claims 27-28: Small teaches a system according to claim 17, wherein the negotiable payment instrument is remove ably attached to the message (see Small, Fig.10 ref. 174).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

5. Claims 17-28 are system claims; they are analyzed below. Method claims 1-8, and 11-16, 29 contain analogous features of claims 17-28; therefore, similar rationales & references for (claims 1-8, 11-16, 29) rejections on 35 USC 103(a) are applied.

6. Re. to claims 27-28, 15-16: They are rejected under 35 U.S.C. § 103(a) as being unpatentable over Small (US Pat. 5,513,117), in view of Susan M Landry's TMA Journal article.

The rationales and reference(s) for 35 USC 102(b) rejection of claim 27 are incorporated.

Small does not expressly disclose that the message and the negotiable payment instrument are printed and removeably attached on the same paper form.

However, in an article about the same subject matter, Landry teaches the echeck is removeably attached in an e-mail birthday greeting (see Landry, page 5, para. 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Small's disclosure and Landry's suggestion to clearly disclose that a message and a negotiable payment instrument are printed and removeably attached on the same paper form

for convenience in distributing both documents at the same time, and easy to tear-off from perforation lines.

7. Regarding claims 1, 6-7: They are method claims that contain equivalent features/steps of using an apparatus of claim 17; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth (please note that a limitation of claim 7 states: "enabling a sender to select the recipient from an address book listing available recipients" is merely a decision to make by looking up a database - this action is obviously performed in claim 19).

8. Regarding claim 2 : It is a method claim that contains equivalent features/steps of using an apparatus of claim 20; therefore, it is rejected on 35 USC 103(a) with similar rationales and references set forth (please note that claim 20 sufficiently mentions 2 limitations of selecting by a sender, and present a gift based on a selected occasion).

9. Regarding claim 3: It contains steps that describing a use of an apparatus in claims 17-18; therefore, it is rejected on 35 USC 103(a) with similar rationales and references set forth.

10. Regarding claim 8: It contains features that are equivalent to a use of an apparatus of claim 22 (merely able to edit information); therefore, they are rejected on 35 USC 103(a) with similar rationales and references set

forth.

11. Regarding claim 4: It contains features that are equivalent to a use of an apparatus of claim 19 (merely able to edit information); therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

12. Regarding claim 11: It contains features that are equivalent to a use of an apparatus of claim 23; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

13. Regarding claim 12: It contains features that are equivalent to a use of an apparatus of claim 19; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

14. Regarding claim 13: It contains features that are equivalent to apparatus claim 25; therefore, it is rejected on 35 USC 103(a) with similar rationales and references set forth.

15. Regarding claim 5, 14: They contain features that are equivalent to a use of an apparatus of claim 26; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

16. Regarding claim 15: It contains features that are equivalent to a use of an apparatus of claim 27; therefore,

they are rejected on 35 USC 103(a) with similar rationales and references set forth.

17. Regarding claim 16: It contains features that are equivalent to a use of an apparatus of claim 28; therefore, they are rejected on 35 USC 103(a) with similar rationales and references set forth.

18. Regarding new claim 29: It is a method claim that contain equivalent features in rejected claims 17, and 24; therefore, it is sufficiently rejected on 35 USC 103(a) with a combination of similar rationales and references set forth.

#### ***Conclusion***

19. Claims 1-8, 11-29 are not patentable.

20. Related references:

A. West, (US Pat. 6,011,833 filed 8/11/1998) for a talking bouquet that sufficiently similar to the claimed invention, the differences are no authentication/validate the giving amount of money, and no use of Internet (however, these missing factors were old and well-known to be obvious in combination with West in achieving claimed results).

B. Simpson, (US Pat. 6,453,300 filed 8/19/1999) for a personalized greeting card with electronic storage media and method of personalizing same that sufficiently similar

to the claimed invention, the differences are no authentication/validate the giving amount of money (however, this missing factor was old and well-known to be obvious in combination with West in achieving claimed results).

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-330 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Thomas G. Black can be reached on 703-305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*Cuong H. Nguyen*

*CHN*  
CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3661